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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,787	07/31/2001	Jeffrey J. Grainger	020313-000520US	4834

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/919,787	GRAINGER ET AL.	
	Examiner	Art Unit	
	Janice A. Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on November 8, 2006, wherein:

Claims 1-21 are currently pending;

Claims 1-17, 19 and 20 have been amended;

Claim 21 has been added.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 8, 2006 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 19 is rejected under 35 U.S.C. § 112, first paragraph, as being of undue breadth.

A "single means" claim, i.e. where a means recitation does not appear in combination with another recited element or means, is subject to an undue breadth

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rejection under 35 U.S.C. 112, first paragraph. See *In re Hyatt*, 218 USPQ 195, (CAFC 1983) and MPEP 2164.08(a).

2164.08(a) Single Means Claim

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In *re Hyatt*, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Although the court in *Fiers v. Sugano*, 984 F.2d 164, 25 USPQ2d 1601 (Fed. Cir. 1993) did not decide the enablement issue, it did suggest that a claim directed to all DNAs that code for a specified polypeptide is analogous to a single means claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended the claims and added the following limitations:

providing an interface element that is configured to allow a user to invoke a display of a list and receiving, at the computer system, an input from a user, ***the input corresponding to a first interface element.*** What is an "interface element"? Is it a GUI? If so, how can the input correspond to the first interface element?

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in response to the input, displaying a list of references, wherein the display comprises an identifier corresponding to a reference. Is the display an interface? If so, why does the display comprise an identifier?

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 states that the rows of the second column include a marker when the reference corresponding to the row is associated with the first case file and wherein the rows of the third column include a marker when the reference corresponding to the row is associated with the second case file. What is the applicant identifying as a marker?

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 states as follows:

Non-statutory Subject Matter

- Claims to computer-related inventions that are clearly non-statutory fall into the same general categories as non-statutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "**descriptive material**." □P8□
- **Descriptive material** can be characterized as either "**functional descriptive material**" or "**nonfunctional descriptive material**." □P8□

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- **"Functional descriptive material"** consists of data structures and computer programs which impart functionality when encoded on a computer-readable medium. □P8□
- **"Nonfunctional descriptive material"** includes but is not limited to music, literary works and a compilation or mere arrangement of data. □P8□
- Both types of "descriptive material" are Non-statutory when claimed as descriptive material per se. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases. □P8□
- When nonfunctional descriptive material is recorded on some computer-readable medium, it is not structurally and functionally interrelated to the medium but is merely carried by the medium. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. □P8□
- - (a) **Functional Descriptive Material: "Data Structures"**
Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se □P9□
- Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical "things" nor statutory processes. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. □P9□
- In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the medium which permit the data structure's functionality to be realized, and is thus statutory. □P9□
- Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things," nor are they statutory processes, as they are not "acts" being performed. □P9□
- In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus statutory. □P9□
- Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-

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readable medium needed to realize the computer program's functionality, as Non-statutory functional descriptive material. ☐P9☐

- When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. ☐P10☐
- When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim. ☐P10☐

(b) Nonfunctional Descriptive Material

- Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. ☐P10☐

Claim 20, as written, is claiming only instructions. Thus, the claim is not statutory.

To render the claim statutory, the applicant may amend to define the invention as:

A computer program embodied on a computer-readable medium, the computer program comprising a set of instruction that when executed by a computer cause the computer to perform the steps of:

providing a user with access....

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette) in view of Petruzzi et al (US 6,049,811) (hereinafter referred to as Petruzzi).

Referring to Claims 1-9 and 19-20:

Rivette discloses a system, program and computer implemented method of managing electronic documents comprising:

a processor (Figure 11 (1106), paragraph [0285]) and computer readable medium in communication with the processor comprising a set of instructions executable by the processor for performing the method of [0289-0290];

providing a user with access to a plurality of electronic documents (Figure 3 (316), [0277] [0304], [0311]);

associating a first set of electronic documents, comprising one or more of a plurality of electronic documents, with a first case, wherein the first case corresponds to a patent application, and wherein associating the first set of electronic documents with the first case comprises identifying the first set of electronic documents as relevant to the first patent application (Figure 2, [0020], [0023-0024][0278];

associating a second set of electronic documents, comprising one or more of a plurality of electronic documents, with a second case corresponding to a second patent application, and wherein the associating comprises identifying the second set of electronic documents as relevant to the second patent application (Figure 2, [0264]);

allowing the user to select at least one electronic document in the second set [0292], [0354-0355] [1193]); and

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associating the selected document to the first case, wherein the first and second case are related cases, or have a common inventor, or same assignee, or relate to a continuation or CIP ([0261-0262] [0349-0357], [0366], [0373-0379] [1157-1159], [0133], Figure 100).

While Rivette discloses searching and storing and retrieving relevant documents to a patent application, Rivette does not disclose using the information in the process of generating an information statement in a form suitable for filing with an official patent office.

However Petruzzi discloses an electronic information disclosure statement and incorporating, with an automated process, at least some of the extracted information from the electronic document into an electronic information statement wherein the at least one electronic document includes information corresponding to a plurality of fields in the electronic information disclosure statement, and wherein incorporating at least some of the extracted information comprises storing the information in the corresponding plurality of fields in the IDS (Figure 2 (Forms 39) col. 2, lines 65-67 col. 5, line 48 thru col. 6, line 7 The Form 1449 for submitting information in the form of patents, publications, etc is provided, operator is prompted for references, a brief description of each reference and the relevance. After information is inputted, the computer automatically generates a first draft).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the searching and storage of relevant documents disclosed in Rivette the electronic IDS taught in Petruzzi so that once the relevant documents are

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identified, the applicant is able to comply with the rules and regulations of the patent office by submitting the relevant prior art as required.

Referring to Claim 2:

Rivette discloses displaying the second case and links to the second set for the user (Figure 145A [0125-0126] [1222]).

Referring to Claim 3:

Rivette discloses wherein displaying the second case further comprises displaying a third case and links to a third set of documents, the third case corresponding to a third patent application (Figure 145A, [0125-0126], [1225-1228]).

Referring to Claim 4:

Rivette discloses displaying identifiers corresponding to each of the references in the first and second sets in individual rows of a first column, and displaying first and second case identifiers at the top of second and third columns, wherein the rows of second column include a marker when the electronic document corresponding to the row is associated with the first case and wherein the rows of the third column include a marker when the electronic document corresponding to the row is associated with the second case (The Examiner is unclear what the applicant is trying to claim with this language, but applies prior art as best as the Examiner understands the claim language)(Figure 6 [0303-0309], Figures 13-17, Figures 33-38).

Referring to Claim 10:

Rivette discloses displaying a search screen to search for additional cases (Figure 53) [0388-0417 Searching Module]).

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Referring to Claims 11-13:

Rivette discloses wherein the electronic documents is an electronic version of a US Patent or a foreign patent document, or a publication [0376].

Referring to Claim 14:

Rivette discloses storing at least some of the plurality of electronic documents in a database or storing information from at least some of the plurality of electronic documents [0373-0379], [0453] [1157-1159],[1193].

Referring to Claim 15:

Rivette discloses allowing the user to search the web [0484-0485] [1209-1212].

Referring to Claim 16:

Rivette discloses allowing the user to search a database, wherein the database is maintained by an official patent office [0321].

Response to Arguments

7. Applicant's arguments filed November 8, 2006 have been fully considered but they are not persuasive.

As for applicant's arguments that Rivette does not teach or suggest an Information Disclosure Statement, the applicant's arguments are moot in view of the new grounds of rejection.

As for applicant's argument that Rivette fails to teach or suggest providing an interface element that is configured to allow the user to identify a first reference as being relevant to a first patent applicant, the Examiner notes that it is not clear what applicant is defining the "interface element" as and directs the applicant to the rejection under 35 USC 112, 2nd paragraph.

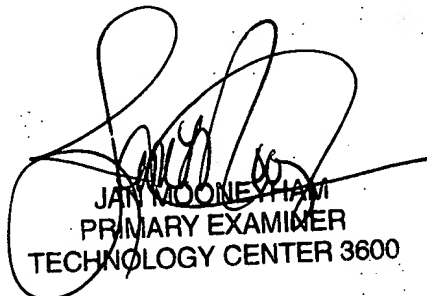
Furthermore, the language "in response to the first input, displaying a list of the second set of references" the Examiner asserts that the language "receiving at the computer system" an input from the user, does not require the input be received by the computer or that the display be on the computer.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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